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In re Application of MONIER et al. :
Application No.: 10/573,523 : DECISION ON PETITION
PCT No.: PCT/FR04/02407 :
Int. Filing: 24 September 2004 : UNDER 37 CFR 1.47(b)
Priority Date: 24 September 2003 :
Attorney Docket No.: BLO-113/PCT/US :
For: SYNCHRONOUS RECTIFICATION DEVICE:
AND SYNCHRONOUS ELECTRICAL MACHINE:
IMPLEMENTING SAME :

This is a decision on applicant's petition under 37 CFR 1.47(b), filed in the United States Patent and Trademark Office (USPTO) on 14 May 2007, to accept the application without the signatures of joint inventors, STEPHAN MONIER and JEAN-YVES LE GOUIL. Applicant's request for a four month extension of time is granted.

BACKGROUND

On 23 March 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 13 November 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 14 May 2007, applicant filed the instant petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requests the acceptance of the application without the signatures of the inventors alleging that Mr Monier and Mr. Le Gouil are unavailable to sign the application.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1) with payment of the requisite petition fee and Item (3) with a statement of the last known address of the inventors.

With regard to Item (2), Petitioner has not provided a statement of first hand knowledge of the facts of the refusal by the inventors.

Petitioner provided a copy of an email from Sylvia Lee, patent specialist for Lumen Intellectual Property Services to Bloch Associates. The email, dated 20 November 2006, indicates that she forwarded a declaration, assignment and power of attorney for reference number "Lumen Ref. BLO-113/PCT/US" for signature of the inventors. It is clear that a complete copy of the application papers was not forwarded.

Petitioner also provided (Exhibit 2) a letter dated 11 May 2007 from Sabrina Crozier to Cabinet Bloch & Gevers. The letter states that a declaration was forwarded to Mr. Monier on 12 January 2007 and a reminder was sent on 27 April 2007, with no response. Attached as Exhibit 3 are letters (dated 12 January 2006 and 27 April 2007) to the nonsigning inventors in the French language without English translation. An English translation of these letters is required if they are to be relied upon as evidence of the inventors' refusal.

Petitioner must provide proof that the inventor was presented with a copy of the application papers (including specification, claims, and any drawings) in order to conclude that the inventor refuses or is unavailable to sign the application. See MPEP. 409.03(d), which states in pertinent part, "a refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers." Here, it does not appear that the nonsigning inventor was presented with a copy of the application papers. Also there is no evidence that Messrs. Monier and Le Gouil actually received the application papers including declaration. Petitioner must present sufficient evidence to conclude that the inventors refuse to sign the application. The statement of someone having first hand knowledge of the facts is required. See MPEP. 409.03(d) for further instructions. Item (2) is not satisfied.

As for Item (4), petitioner has not provided a declaration, in compliance with 37 CFR 1.497(a) and (b) and executed on behalf of the inventors by the 37 CFR 1.47(b) petitioner. Such declaration is required. Thus, Item (4) is not satisfied.

Regarding Item (5), Section 409.03(f) of the MPEP, Proof of Proprietary Interest, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an

application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

No assignment signed by the inventors was attached to the petition to prove this interest. No written agreement by the inventors to assign was presented.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such memorandum accompanied the petition. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage." No such statement has been presented. Thus, item (6) is not yet satisfied.

Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.


CONCLUSION

The petition under 37 CFR 1.47(b) is DISMISSED WITHOUT PREJUDICE.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional

petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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